



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,392	11/29/2001	Bhupesh Gupta	AUS920011027US1	7315

46073 7590 01/09/2008  
IBM CORPORATION (VE)  
C/O VOLEL EMILE  
P. O. BOX 162485  
AUSTIN, TX 78716

EXAMINER
----------

TRAN, QUOC A

ART UNIT	PAPER NUMBER
----------	--------------

2176

MAIL DATE	DELIVERY MODE
-----------	---------------

01/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

*MN*

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/998,392	GUPTA, BHUPESH	
	Examiner	Art Unit	
	Tran A. Quoc	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

In view of the Appeal Brief filed on 09/21/2007, PROSECUTION IS HEREBY REOPENED. A **Non-Final** rejection set forth below.

Claims 1-15 are currently pending. Claims 1, 4, 7, 10, and 13-15 are independent claims, effective filing date 11-29-2001.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

*/Doug Hutton/*  
Doug Hutton  
Supervisory Primary Examiner  
Technology Center 2100

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

**Claims 1-15** rejected under 35 U.S.C. 103(a) as being unpatentable over **Khan**

**US006546393B1**, filed 10/07/1999 (hereinafter Khan), in view of **Nielsen**

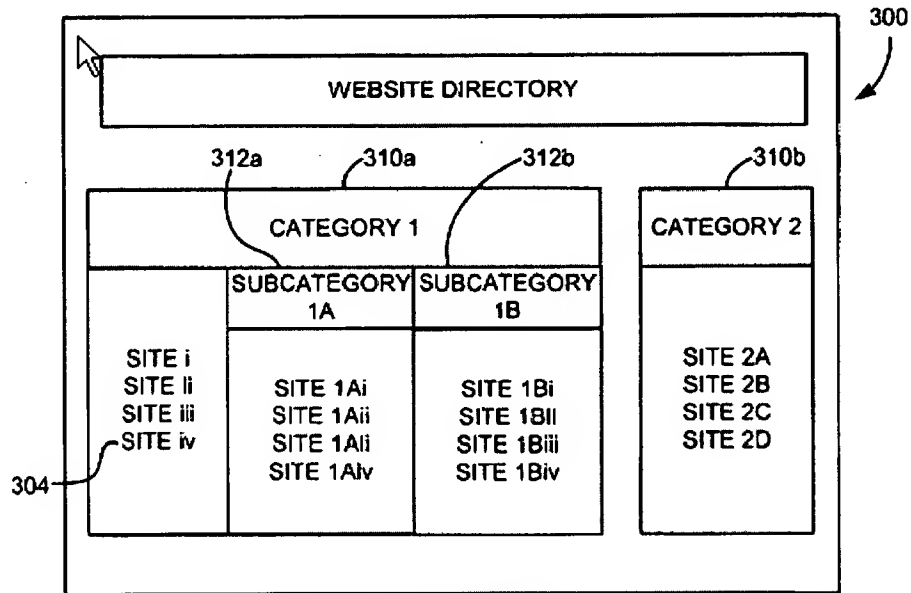
US005761436A, filed 07/01/1996 (hereinafter Nielsen).

Regarding ***independent claim 1***, Khan teaches:

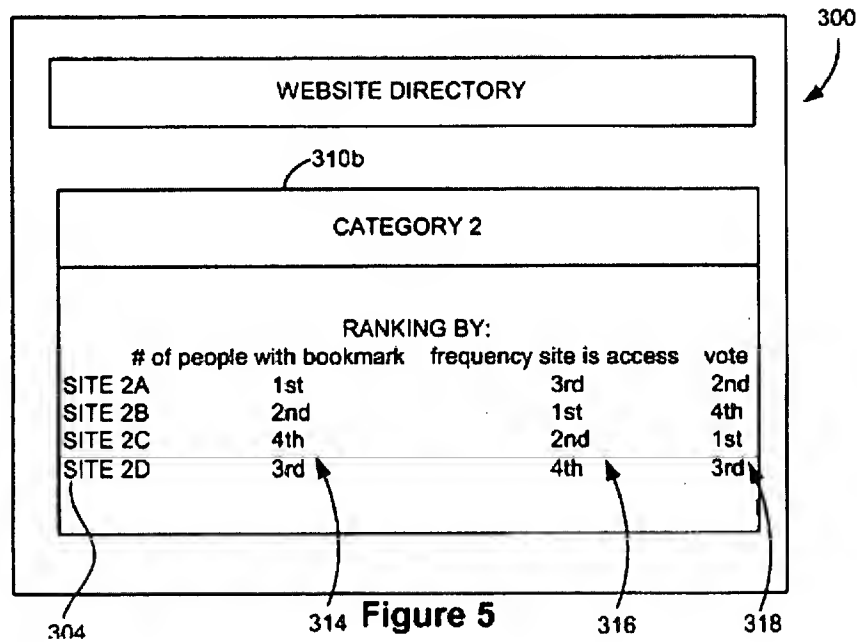
**comparing bookmarked Web pages in a bookmark folder with  
the Web pages in the categories;**

(See Khan at Col. 21, Lines 25-45, discloses "Check Duplicates" bookmark, wherein comparing all the bookmarks and their titles/summaries stored, the bookmark management system identifies duplicate bookmarks stored in an user's online bookmark account.

Also see Khan at Fig. 4-5 and Col. 13, Lines 25-35, discloses bookmarked Web pages in a bookmark folder with the Web pages in the categories.)



**Figure 4**



**Figure 5**

In addition, Khan does not explicitly teach, but Nielsen teaches:

**A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:  
highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.**

(See Nielsen at Fig. 5 and Col. 7, Lines 40-55, discloses An "Aggregate Flag" field 521 contains a boolean flag that if TRUE identifies the history data record 510 as an aggregate record. An aggregate record links to history data structures containing similar hyperlinks. Using the broadest reasonable interpretation, the Examiner equates the claimed **highlighting** as equivalent to An "Aggregate Flag" as taught by Nielsen. This interpretation is supported by the Applicant's disclosure, which states, " Note also that here highlighted fashion encompasses any manner of distinguishing already bookmarked Web pages from those that have not been bookmarked," See Applicant Specs Page 22 Lines 10-16.)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Khan's teaching of comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories, to include a means of highlighting all the Web pages in the categories that are the same as the bookmarked Web pages as taught by Nielsen. One of ordinary skill in the art would have been motivated to modify this combination because Khan and Nielsen are from the same field of endeavor of bookmarks schemes in the client/server, and provides a predictable

result of "Check Duplicates" bookmark, wherein comparing all the bookmarks and their titles/summaries stored, the bookmark management system identifies duplicate bookmarks stored in an user's online bookmark account- See Khan at Col. 7, Lines 40-55.)

***Regarding independent claim 4:***

is directed to computer program product on a computer readable medium to perform a method of claim 1 which cites above, and is similarly rejected under the same rationale (see Khan fig. 1).

***Regarding independent claim 7:***

Is directed to computer implemented apparatus to perform a method of claim 1 which cites above, and is similarly rejected under the same rationale (see Khan Fig. 1).

***Regarding independent claim 10:***

is directed to computer system embodied therein at least one memory, and at least one processor to perform a method of claim 1 which cites above, and is similarly rejected under the same rationale (see Khan fig. 1).

*Regarding independent claim 13:*

The rejection of claim 1 is fully incorporated.

In addition, Khan teaches:

**Accessing a Web page on the server on which Web pages  
arranged in categories are displayed;**

(See Khan at Fig. 4 and Col. 12, Lines 30-45, discloses accessing a Web page on which Web pages arranged in categories are displayed. Also Khan further discloses the user has a server side bookmark account set up and populated- See Khan at Col. 11, Line 55.)

**retrieving Uniform Resource Locators (URLs) of all Web pages  
in a bookmark folder, the bookmark folder being stored either on a  
client computer system or on the server, the bookmark folder, if  
stored on the server, being enabled to be accessed by a plurality of  
users;**

(See Khan at Col. 16, Lines 1-15, discloses all the URLs that users add to their current online bookmark account) through the "Adding Bookmarks Remotely" feature may be stored in their online bookmark account and are accessible from any computer on the Internet, just like all their other bookmarks in their online bookmark account. When a user wishes to bookmark a particular page using this function, the user first accesses the particular page through their browser. Once the user is thereat the particular page, the user may add a bookmark remotely by clicking on, for example, the ADD2My\_Stuff



favorite/bookmark in their current browser. The URL of the particular page is then stored in their My\_Stuff folder (i.e. bookmark folder).

Also see Khan at Col, 16, lines 25-35, discloses sharing bookmarks.)

*Regarding independent claim 14:*

The rejection of claim 13 is fully incorporated.

In addition, Khan teaches:

**remote computer system and being enabled to be viewed by a plurality of users, however, only bookmarked Web pages in the bookmark folder for which a user has access permission may be accessed by the user;**

(See Khan at Col, 16, lines 25-35, discloses sharing bookmarks and publishing them on the internet. Also see Khan at Col. 15, Lines 60-65, discloses remotely access the bookmarks. Also see Khan at Col. 14, Lines 30-40, discloses a user signs up, the user may be set up with a personal, password-protected, web-based online bookmark account. Also see Khan at Col. 11, Lines 45-55, discloses the only people allowed to add links to the web directory are users who host their bookmarks or favorite sites in online bookmark accounts 302a, 302b, 302c on an online bookmark management server. )

**A computer implemented method of indicating Web pages on  
a server that have already been bookmarked on a local computer  
system comprising the steps of:**

(See Khan at Col. 21, Lines 25-45, discloses "Check Duplicates" bookmark, wherein comparing all the bookmarks and their titles/summaries stored, the bookmark management system identifies duplicate bookmarks stored in a user's online bookmark account.)

*Regarding independent claim 15:*

The rejection of claim 13 is fully incorporated.

In addition, Khan teaches:

**A computer implemented method of indicating Web pages on  
a server that have already been bookmarked on a local computer  
system comprising the steps of:**

(See Khan at Col. 21, Lines 25-45, discloses "Check Duplicates" bookmark, wherein comparing all the bookmarks and their titles/summaries stored, the bookmark management system identifies duplicate bookmarks stored in a user's online bookmark account.)

*Regarding claim 2, Khan teaches:*

**The computer implemented method of Claim 1 wherein the  
bookmark folder is on a client.**

(See Khan at Col. 15, Lines 60-65, discloses remote addition for adding bookmark at the user's web browser without access onto online bookmark account.)

*Regarding **claim 3**, Khan teaches:*

**The computer implemented method of Claim 1 wherein the bookmark folder is on a server.**

(See Khan at Col. 13, Lines 35-40, discloses the server side bookmarks.)

*Regarding **claims 5-6** respectively:*

Are directed to computer program product on a computer readable medium to perform a method of claims 2-3 respectively, which cite above, and are similarly rejected under the same rationale (see Khan Fig. 1).

*Regarding **claims 8-9** respectively:*

Are directed to computer implemented apparatus to perform a method of claims 2-3 respectively, which cite above, and are similarly rejected under the same rationale (see Khan Fig. 1).

*Regarding **claims 11-12** respectively:*

are directed to computer system embodied therein at least one memory, and at least one processor to perform a method of claims 2-3 respectively, which cite above, and are similarly rejected under the same rationale (see Khan fig. 1).

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Application/Control Number:  
09/998,392  
Art Unit: 2176

Page 12

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quoc A, Tran/  
Patent Examiner  
Art Unit 2176  
01/06/2008

*/Doug Hutton/*  
Doug Hutton  
Supervisory Primary Examiner  
Technology Center 2100